



501.18758C14

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: K. SHIMOHIGASHI et al.
Serial No.: 08/448,138
Filed: May 23, 1995
For: SEMICONDUCTOR MEMORY
Group: 2511
Examiner: T. Fears

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T. Fears
GROUP 2500

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RESPONSE

Honorable Commissioner of
Patents and Trademarks
Washington, D.C. 20231

September 5, 1996

Sir:

In response to the Office Action dated June 5, 1996,
applicants provide the following response.

Reconsideration and removal of the rejection of claims
1-6 over U.S. Patent No. 5,093,602 is respectfully requested.
In the Office Action, it is indicated that U.S. Patent No.
5,093,602 is "Applicant's patent." However, in fact, USP
5,093,602 is a patent to Arnold J. Kelly entitled "Methods and
Apparatus for Dispersing a Fluent Material Utilizing an
Electron Beam" which, on information and belief, is assigned
to Charged Injection Corporation in New Jersey. As such, USP
5,093,602 is not one of applicants' patents.

Also, it is respectfully submitted that the subject
matter defined in claims 20-25 of the present application is
completely different than the subject matter defined in claims

1-6 of USP 5,093,602. More specifically, the present claims are directed to a semiconductor memory whereas the claims of USP 5,093,602 are directed to an apparatus for dispersing a fluent material. Therefore, reconsideration and removal of the rejection of claims 20-25 based on U.S. Patent No. 5,093,602 is earnestly solicited.

It appears that the rejection set forth in the Office Action may have been based on another one of the applicants' patents from one of the numerous parent applications in this case. However, from a review of the patents from the previous applications, it does not appear that the numbers of any of these parent patents are close to the number 5,093,602. Therefore, if it was actually the Examiner's intention to rely on a patent in the series of parent applications, it is respectfully requested that a new Office Action be issued detailing this intention. On the other hand, if it was the Examiner's intention to rely on some other patent owned by the same assignee, Hitachi, Ltd., it is requested that this matter be clarified in a new Office Action. In any event, it is not possible for the applicants to ascertain from the Office Action what the exact intentions were.

In addition to the above comments, applicants wish to point out that the case of In re Schneller, 158 USPQ 212 (CCPA 1968) is a case which was very much limited to the particular facts set forth therein. This is apparent from the citation in Schneller of other cases which clearly support the issuance of two separate patents when the claims are not obvious over

one another. Cases by the CAFC, including the recent case of In re Goodman, 29 USPQ2d 2010 also clearly permit issuance of two separate patents when the claims are not obvious relative to one another. Inasmuch as the applicants do not know exactly which patent or which claims the rejection set forth in the last Office Action refers to, it is not possible for applicants to provide detailed comments to traverse this rejection at the present time. However, it is respectfully requested that the Examiner carefully consider the limitations of the decision of In re Schneller to the particular facts of that case before issuing any further double patenting rejection since, as noted above, far and away the majority of previous case law supports the principle that claims which are not obvious relative to one another support separate patents.

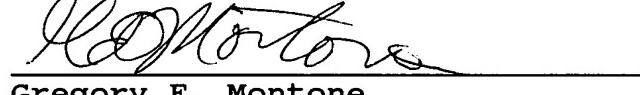
If the Examiner believes that there are any other points which may be clarified or otherwise disposed of, either by telephone discussion or by personal interview, he is invited to contact applicants' undersigned attorney at the number indicated below.

To the extent necessary, the applicants petition for an extension of time under 37 CFR 1.136. Please charge any shortage in the fees due in connection with the filing of this paper, including extension of time fees, to the deposit account of Antonelli, Terry, Stout & Kraus, Deposit Account

No. 01-2135 (501.18758C14), and please credit any excess fees
to said deposit account.

Respectfully submitted,

ANTONELLI, TERRY, STOUT & KRAUS



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